

REMARKS

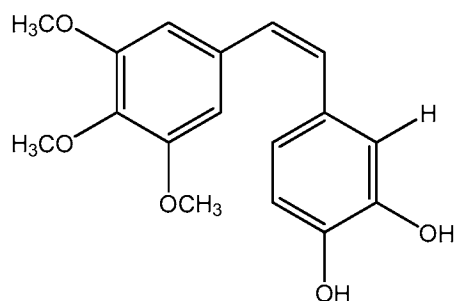
Applicant respectfully requests reconsideration of the present application in view of the reasons that follow. Claims 14, 38 and 41 are canceled. Claims 4, 10, 15, 34, 35, 39, 40, 42 and 57 are amended as discussed below. After entrance of the present amendment, claims 4, 10, 12, 13, 15, 16, 34-37, 39, 40, 42, 57 and 58 are pending.

35 U.S.C. § 112, second paragraph

Claims 14, 15, 38, 39, 41 and 42 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 14, 38 and 41 are canceled, rendering the rejection moot. Claims 15, 39 and 42 are amended to delete reference to hydroxyl as a potential substituent.

35 U.S.C. § 102 - anticipation

Claims 4, 10, 12-16, 34-39, 41, 42, 57 and 58 stand rejected under 35 U.S.C. § 102(b) as being anticipated by US 5,409,953. In support of the rejection, the Office identifies a compound of Formula (I) where "R1 and R2 are methoxy, R4 is -OH and R3 is-H." The compound is illustrated below:



Claim 4 is amended to recite that the B ring (which contains the ortho-catechol moiety) is additionally substituted with one to five substituents. Claim 10 and 34 are amended to incorporate the limitations of claims 14 and 38, respectively. Claim 57 is amended to delete one member of the Markush group. Claims 14, 38 and 41 are canceled as redundant. Claims 15, 35, 39, 40 and 42 are amended to provide correct antecedent support and remove reference to canceled claims. As amended, each of independent claim 4, 10 and 34 requires a non-hydrogen substitution on the same phenyl ring as the ortho-catechol moiety. Thus the compound identified by the examiner does not fall within the scope of the claims, as amended. Application requests withdrawal of the rejection.

Double Patenting

Claims 1-4, 10-16, 34-42 and 57 stand rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-5 of U.S. Patent No. 6,919,324. Applicant submitted a properly executed Terminal Disclaimer, including the required fee under 37 CFR §1.20(d) with the Reply filed on 12 August 2010. The Examiner states that the Terminal Disclaimer is disapproved, but does not explain why, nor has the Office provided any notice to Applicant indicating how the Terminal Disclaimer might be deficient. Applicant requests entry of the previously submitted Terminal Disclaimer.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-4279. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-4279. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-4279.

Respectfully submitted,

By:

Date 1 June 2011

Customer Number: 75605

Telephone: (650) 284-5575

Facsimile: (650) 284-5596

/Karen E. Flick/

Karen E. Flick

Attorney for Applicant

Registration No. 44,111